

REMARKS

Substance of Interview

Applicant's representative Elliott Mason (Reg. No. 56,569) thanks the Examiner for the telephone interview on July 10, 2007. In accordance with MPEP Section 713.04, the substance of the interview is included herein. No exhibits were shown. Claims 1, and 23 – 25 were discussed with respect to the cited reference Kern. The basis for the rejections were discussed, however, no agreement was reached. With respect to claim 1, the Examiner essentially reiterated his explanation from page 2 of the Office Action that he was interpreting the phrase "the wavefront data is configured according to a selected high-order aberration correction" as reading on the instructions stored in the memory of Kern because the electrodes of Kern could be configured to correct a selected high-order aberration. With respect to claims 23, 24 and 25, the Examiner explained that he was not giving patentable weight to the limitations of these claims, since they were being treated as merely "intended use."

Prior Art Rejections

Claims 1, 9-11, 15-17, 21, 22, 24, and 25 stand rejected under 35 U.S.C. 102(b) as anticipated by Kern (U.S. 4,601,545). Claims 8, 13, 14, and 23 stand rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Rizzo (U.S. 5,800,530). Claim 20 stands rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Sandsted (U.S. 6,749,632). Claim 26 stands rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Nelson (U.S. 7,127,299).

Claim 1

Applicant submits that Kern neither discloses nor suggests at least that "the wavefront data is configured according to a selected high-order aberration correction to modify the characteristic function of the optical element to reduce high-order aberration in the eye," as recited by claim 1.

In the present Office Action, as in the previous Office Action, the Examiner is interpreting the RAM or ROM in the CPU 54 as the recited "memory element," and the "instructions regarding distribution of voltage levels" as the recited "wavefront data." The

Examiner refers to col. 5, lines 45-47 as disclosing an "aspheric lens effect ... which reduce high order, or spherical, aberration."

As explained above, the Examiner is interpreting the phrase "the wavefront data is configured according to a selected a high-order aberration correction" as reading on the instructions stored in the memory of Kern because the electrodes of Kern correct a selected high-order aberration. It appears that the Examiner is making an argument that Kern inherently discloses that the instructions stored in the memory are configured according to a selected high-order aberration correction, as Kern does not explicitly disclose that the instructions stored in the memory are configured according to any aberration correction, much less, a "selected a high-order aberration correction."

Applicant respectfully points out that "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In Kern, not only are there other possibilities for configuring the instructions in the memory besides "according to a selected high-order aberration correction," as the claim requires, but Kern specifically describes that it is the electrode arrangements that achieve effects such as the "aspheric lens effect" which provide the aberration correction. Thus, Applicant submits that the rejection of claim 1 is based on a clear error in establishing a valid *prima facie* anticipation rejection based on inherency, and requests reconsideration.

Dependent claim 23 – 25

Applicant submits that no proper combination of Kern and Rizzo teaches or suggests that the "wavefront data depends on an estimate of a distance to an object-of-regard, as recited by claim 23. Applicant submits that Kern does not disclose that the "memory element is configured to enable the wavefront data to be re-programmed in situ," as recited by claim 24, or that the "memory element is configured to enable the wavefront data to be re-programmed by transmitting data over a wireless link," as recited by claim 25.

For each of these dependent claims, the Examiner asserted the recited limitations were not being given patentable weight since they were being interpreted as merely intended use. In the Examiner's interview summary filed on July 25, 2007, the Examiner states with respect to claims 1, 23 – 25 that "the limitations, of intended use, failed to positively recite additional structure beyond Kern and Rizzo." Applicant submits that the failure to give these claims patentable weight is a clear error, since these claims go beyond mere intended use and place further limitations on the claimed memory element (claims 24 and 25) or on the wavefront data stored therein (claim 23).

Furthermore, such basis for rejection is in apparent contradiction to the Examiner's own rejection of claim 26, which depends on claim 25, in which the Examiner states "Kern [meets] the structural limitations of claim 26 as described above but [lacks] the express written disclosure of the wireless transmission being encrypted," and goes on to argue that Nelson provides the missing disclosure. Applicant submits that limitations of claims 23 – 25 are just as worthy of consideration as claim 26 as further limiting the respective base claim, and not merely reciting an intended use.

Thus, Applicant submits that the rejection of claim 23 is based on a clear error in establishing a valid *prima facie* obviousness rejection, and the rejections of claims 24 and 25 are based on a clear error in establishing a valid *prima facie* anticipation rejection, and requests reconsideration.

Dependent claims 9-11, 15-17, 21, 22

These dependent claims are all properly dependent on claim 1, are thus allowable therewith. These dependent claims also add one or more further limitations, which are not presently relied upon to establish patentability. For that reason, and not because Applicant agrees with the Examiner, no rebuttal is offered to the Examiner's reasons for rejecting these dependent claims.

Dependent claims 8, 13, and 14

No proper combination of Kern and Rizzo teaches or suggests the subject matter found to be lacking in Kern. The these dependent claims are all properly dependent on claim 1, and are

thus allowable therewith. These dependent claims also add one or more further limitations, which are not presently relied upon to establish patentability. For that reason, and not because Applicant agrees with the Examiner, no rebuttal is offered to the Examiner's reasons for rejecting these dependent claims.

Dependent claim 20

No proper combination of Kern and Sandsted teaches or suggests the subject matter found to be lacking in Kern. Claim 20 is properly dependent on claim 1, and is thus allowable therewith. Claim 20 also adds one or more further limitations, which are not presently relied upon to establish patentability. For that reason, and not because Applicant agrees with the Examiner, no rebuttal is offered to the Examiner's reasons for rejecting claim 20.

Dependent claim 26

No proper combination of Kern and Nelson teaches or suggests the subject matter found to be lacking in Kern. Claim 26 is properly dependent from claim 1, and is thus allowable therewith. Claim 26 also adds one or more further limitations, which are not presently relied upon to establish patentability. For that reason, and not because Applicant agrees with the Examiner, no rebuttal is offered to the Examiner's reasons for rejecting claim 26.

No fee is believed due. Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 00633-041001.

Respectfully submitted,

Date: August 20, 2007

/Elliott J. Mason, III/

Elliott J. Mason, III Rcg. No. 56,569

Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (617) 542-8906